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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,591	01/03/2001	Jesse A. Jurrens	JURRENS	1866

7590

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EXAMINER

RODRIGUEZ, PAMELA

ART UNIT

PAPER NUMBER

3613

DATE MAILED: 01/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/753,591

Applicant(s)

JURRENS, JESSE A.

Examiner

Pam Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2001 and 03 December 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 21 November 2001 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

1. The amendment filed on November <sup>6<sup>th</sup></sup> 21<sup>st</sup> has been received along with the supplemental amendment which applicant graciously re-transmitted to the office on December 3, 2001.

### *Drawings*

2. The proposed drawing correction submitting new Figure 6, filed on November 21<sup>st</sup> has been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of Figure 6 and all the particulars of the swing arm structure as described in paragraph 3 below in the cited new matter passages. The substitute sheets for Figures 1-5 however have been entered. Therefore the previous drawing objection in paragraph 2 of the previous office action is repeated below.
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the swing arm with its pairs of arms, wheel mounts, connectors, and upper, lower, and intermediate transverse cross members must all be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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***Specification***

4. The substitute specification filed November 21st has not been entered because it does not conform to 37 CFR 1.125(b) because: it lacks a marked up copy and because it contains new matter as outlined below.

5. The amendment to the specification (substitute specification) filed November 21st is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The new matter is present in newly added paragraph 0041 on page 17, more specifically lines 16-18 and the phrase "Disposed...90", lines 20-21 of that same page and the phrase "extends.....90" is also new matter, and lines 22-25 of the same page and the phrase "by....84". New matter is also present in the entire paragraph 0042 which describes subject matter not previously disclosed.

Applicant is only permitted to describe what was in his original specification and drawings. These aforementioned passages describe new features not originally described in the specification and are therefore deemed new matter.

***Double Patenting***

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to

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identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,003,628. This is a double patenting rejection.

All the limitations of Claim 1 of the instant application are recited word for word in Claim 1 of the '628 patent.

### ***Claim Rejections - 35 USC § 112***

8. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In lines 11, 16, and 18 of Claim 2, the words "its" are indefinite. It is unclear which components the words "its" are referring to.

Claim 2 recites the limitation "the cross member plate" in the second line of subparagraph e. There is insufficient antecedent basis for this limitation in the claim.

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Claim 2 recites the limitation "the lower transverse cross member" in the fourth line of subparagraph e. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Jurrens et al.

Regarding Claim 1, Jurrens et al disclose a suspension system 10 for a motorcycle 12 having all the features of the instant invention including: a motorcycle main frame 14, a swing arm 16 pivotally mounted to the motorcycle main frame 14 about a pivot axis 18, and an air bag suspension system 10, wherein the swing arm 16 has a pair of wheel mounts 20 located on a wheel axis 22 spaced to receive the rear wheel 24, wherein the swing arm 16 further includes pairs of arms 26 and 28 extending from each of the wheel mounts 20 and connectors 30 connecting each pair of arms 26 and 28 (see Figure 7), wherein each connector 30 is joined to the other connector by an upper transverse cross member 32 and a lower transverse cross member 34, and wherein an intermediate transverse cross member 38 extends along the swing arm pivot axis 18 and through the connectors 30 and is secured to the struts 40 of the motorcycle main frame 14 (see column 4 lines 29-57).

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X Regarding Claim 2, Jurrens et al disclose a suspension system 10 for a motorcycle 12 having all the features of the instant invention including: a motorcycle main frame 14, a swing arm 16 pivotally mounted to the motorcycle main frame 14 about a pivot axis 18, and an air bag suspension system 10, wherein the air bag suspension system includes at least one air-bag 54 constructed of an elastomeric material (see column 8 lines 23-25), the air bag is housed within a housing assembly 52' and is secured at one end (see the end nearest element 156 shown in Figure 12) to a piston located within the housing assembly (see Figure 12 and note how the air bag is connected via elements 150, 144 and 160 to the piston rod and hence the piston of the shock absorber 140) and at its other end to an upper plate 116 of the housing assembly 52' (see Figure 12), and the housing assembly 52' is attached to a shock absorber 140 (again via elements 150, 144, and 160 shown in Figure 12), wherein the shock absorber 140 is attached at its forward end to a cross member plate 160 of the motorcycle main frame 14 and is pivotally attached at its rearward end to the lower transverse cross member 34 of the swing arm 16 (see Figure 12 and note that since the brackets 158 form part of the entire suspension assembly encompassing the swing arm lower transverse cross member, the shock absorber is broadly readable as being attached to the member 34 in that all of the suspension assembly components have to be connected somehow).

***Response to Arguments***

11. Applicant's arguments filed November 21, 2001 have been fully considered but they are not persuasive.

With regards to applicant's arguments regarding the double patenting rejection, the examiner contends that Claim 1 of the instant application does still recite the same limitations as that of Claim 1 of the '628 patent. The claimed features of the instant application Claim 1 are all recited or are inherently encompassed in the patent's claim 1.

With regards to applicant's arguments directed towards the 102 Jurrens et al rejection and that the Jurrens reference discloses the use of two air-bags versus the one used in applicant's invention, the examiner contends that applicant's claim language does not require **ONLY** one air bag. Applicant merely claims "an airbag suspension" in Claim 1 and "at least one air bag" in Claim 2. Therefore, as long as the Jurrens et al reference has one air bag, it meets the limitations of the claims.

It is for these reasons that the rejections have been maintained.

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the



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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pam Rodriguez whose telephone number is 703-308-3657. The examiner can normally be reached on Monday-Thursday 6:30am-4 pm and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Schwartz can be reached on 703-308-0576. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

pr  
January 2, 2002

*Pamela Rodriguez*  
**R Pamela J. Rodriguez**  
**Primary Examiner**  
**Art Unit 3613**

1/2/02